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THE JANSSEN FIRM  
9501 North Capital of Texas Highway, #202  
Austin, Texas 78759

In re Application of:	:	
GOUBIN, Louis, et al.	:	DECISION ON PETITION
U.S. Application No.: 10/506,851	:	(37 CFR 1.137(b))
Int'l Application No: PCT/IB03/00946	:	
Int'l Filing Date: 04 March 2003	:	
Priority Date: 07 March 2002	:	
Atty Docket No.: 76.0728 US/PR	:	
For: METHOD FOR MAKING SAFE AN	:	
ELECTRONIC CRYPTOGRAPHY	:	
ASSEMBLY WITH A SECRET KEY	:	

This decision is issued in response to applicant's Petition for Revival under 37 CFR 1.137(b) filed 01 August 2007. Applicants have submitted the required petition fee.

**BACKGROUND**

On 04 March 2003, applicants filed international application PCT/IB03/00946. The application claimed an earlier priority date of 07 March 2002, and it designated the United States. On 12 September 2003, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for filing the basic national fee was thirty months from the priority date, i.e., 07 September 2004.

On 03 September 2004, applicants filed a Transmittal Letter (Form PTO-1390) requesting entry into the U.S. national stage for PCT/IB03/00946, accompanied by, among other materials, the authorization to charge Deposit Account No. 50-2229 for required fees, including the basic national fee. However, the person signing the fee authorization was not an authorized user of the listed Deposit Account.

Because the 03 September 2004 submission did not include a valid fee payment, applicants failed to provide the basic national fee prior to the expiration of thirty months from the priority date. Accordingly, international application PCT/IB03/00946 became abandoned with respect to the United States as of midnight on 07 September 2004.

On 03 June 2005, applicant submitted via facsimile a corrected Transmittal Letter (Form PTO-1390) in which the Deposit Account listed in the fee authorization had been corrected to 50-2299. Specifically, the Form PTO-1390 authorized a charge for \$920 as the basic national

fee, and \$290 as the fee for including a multiple dependent claim. Based on this submission, Deposit Account No. 50-2299 was charged these two fees.

On 25 July 2005, the United States Designated/Elected Office (DO/EO/US) mailed a "Notice Of Insufficient Basic National Fee Required And/Or Missing Copy Of International Application Under 35 U.S.C. 371 and 37 CFR 1.495" (Form PCT/DO/EO/912) indicating that the \$300 basic national fee had not been submitted.

On 01 August 2007, applicants filed the petition considered herein, accompanied by a revised Transmittal Letter (Form PTO-1390) which authorized a charge to Deposit Account No. 50-2114 for required fees, including the \$300 basic national fee, \$400 search fee, \$200 examination fee, and \$360 fee for inclusion of a multiple dependent claim. Based on this authorization, Deposit Account No. 50-2114 was charged the listed fees.

### **DISCUSSION**

#### **1. June 2005 fee submission**

At the time applicants filed, via facsimile, the corrected Form PTO-1390 on 05 June 2005, the present application was already abandoned for failure to timely file the basic national fee. Moreover, as set forth in 37 CFR 1.6(d)(3), the basic national fee in a national stage application cannot be submitted via facsimile. Accordingly, charging Deposit Account No. 50-2214 the fees itemized in the 05 June 2005 facsimile submission, including the \$920 basic national fee, was improper. The \$1,210 in fees charged to Deposit Account No. 50-2214 based on this facsimile transmission is therefore appropriately refunded to applicants.

In addition, because the application was already abandoned for failure to submit the basic national fee prior to the expiration of the thirty-month deadline, the "Notice Of Insufficient Basic National Fee Required And/Or Missing Copy Of International Application Under 35 U.S.C. 371 and 37 CFR 1.495" (Form PCT/DO/EO/912) mailed 25 July 2005, which did not indicate that the application was abandoned, was issued in error. The Form PCT/DO/EO/912 is therefore appropriately vacated.

#### **2. Petition For Revival Under 37 CFR 1.137(b)**

37 CFR 1.137(b) permits the filing of a petition to revive an abandoned application where the abandonment resulted from an unintentional delay. A grantable petition under this section must include: (1) the required reply, unless previously filed; (2) the petition fee required by law; (3) a statement that the "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional;" and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c).

With respect to item (1), the present petition was accompanied by payment of the basic national fee. Item (1) is therefore satisfied.

With respect to item (2), the present petition was accompanied by payment of the required petition fee. Item (2) is therefore satisfied.

With respect to item (3), the present petition includes a statement that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional." It is noted that the present application has been abandoned for an extended period of time. The Office is relying on petitioner's duty of candor and good faith and accepting the statement that the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. See Changes to Patent Practice and Procedure, 62 Fed Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 CFR 10.18 to inquire into underlying facts and circumstances when providing the statement required by 37 CFR 1.137(b) to the Patent and Trademark Office). Based on the above, the statement in the present petition is accepted as satisfying the requirement of item (3) above.

Item (4) does not apply to the present petition.

Based on the above, applicants have satisfied all the requirements for a grantable petition under 37 CFR 1.137(b).

### CONCLUSION

Applicants' petition for revival of international application under 37 CFR 1.137(b) is **GRANTED**.

The \$920 basic national fee and \$290 multiple dependent claim fee charged to Deposit Account No. 50-2299 (based on applicant's 05 June 2005 facsimile transmission) will be credited to applicant.

The "Notice Of Insufficient Basic National Fee Required And/Or Missing Copy Of International Application Under 35 U.S.C. 371 and 37 CFR 1.495" (Form PCT/DO/EO/912) mailed 25 July 2005 is hereby **VACATED**.

The application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for further processing in accordance with this decision, including the mailing of a "Notification Of Missing Requirements" (Form PCT/DO/EO/905). It is noted that applicants have not filed an executed declaration in compliance with 37 CFR 1.497.



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